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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,702	07/02/2001	Benjamin W. Slivka	3382-59319	4420

7590

06/25/2003

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EXAMINER

HARRELL, ROBERT B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 06/25/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/898,702

Applicant(s)

SLIVKA ET AL.

Examiner

Robert B. Harrell

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) <sup>28-35</sup>~~37-56~~ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-35 and 37-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12. 6) ☒ Other: *See Attached Office Action*.

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1. Claims 28-35 and 37-56 remain for examination.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or

3. Claims 28-35 and 37-56 are rejected under 35 U.S.C. 102 (e) as being anticipated by Fawcett (5,845,077).

4. The grounds for rejecting the claims as presented in examiners prior Office Action (mailed December 16, 2002 (paper #9)), continue and are hereby incorporated in this action by reference.

5. The Applicant's Remarks and Arguments filed April 22, 2003 (paper #11) have been considered but they do no place the

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application in condition for allowance for the reasons set forth below.

6. The Applicant argued in substance that:

a) Fawcett does not teach or suggest an installer starting instructions arranged within the distribution file to be automatically executed upon completion of extraction of the software. However, such was covered in col. 8 (lines 40-63) and/or col. 9 (lines 59-63). Such was the "installation application" as covered in col. 9 (line 62) and further covered in col. 9 (lines 52-54). That is, the obtained software obtained was a self extracting packet. Once the software packet was extracted, the software update was automatic per col. 9 (line 51-et seq.));

b) the service update application that installs the software on the user computer is located on the update service computer. However, since Fawcett fails to teach the service update computer had direct access to the user's hard disk (eg., via FTP for example) to directly transfer the required components onto the hard disk, it was anticipated that the service update computer transmitted an installation application along with the software thus making the transmitted packet a self-extracting and

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installing software packet. In this manner, the software and installation code were transmitted to the user's computer which would use the installation code (application) to extract the software which was then automatically placed onto the user's hard drive in the correct directories.

7. The applicant also cited limitations from claims 28-35, 37-52, and 54-55 and then states Fawcett fails to teach such limitations. However, such were covered in examiner's prior action as covered by Fawcett.

8. In conclusion, Fawcett taught self extracting software that was transmitted from the service computer to the user's computer. Once loaded, the extraction could either be automatic or delayed. In either case, once the extraction process began, the user's computer would execute self extraction code that would extract the software from a compressed form, and once extracted automatically installed into the correct directories on the user's hard drive. That is, along with the software was code to extract compressed software and install the decompressed software accordingly onto the user's computer. Such was covered by Fawcett, as indicated above, and well known in the art. Self extract software (also known as "self extracting files") is not a new innovation where a file had the compressed target software

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stored along with decompressing code and installation codes which extracts the software for a compressed form and places the corresponding sections of the software into the correct directory locations.

9. Per claim 56, this newly presented claim is rejected also for all the reasons provided above.

10. "How to run Doom?" by Daniel L. Jenkins from the newsgroup alt.games.doom.newplayers is added to the record, not as any portions of a rejection, but a general teachings of "self extracting file". A game called "DOOM", available as of 1994, was distributed over the Internet. Once obtained, a program called "Install" was executed that called upon another program in the distribution file called "DEICE" that decompressed the game, placed all required files into their correct directories and prepared the game program for play. The whole process was automatic.

10. THIS ACTION IS MADE FINAL. The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

11. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY

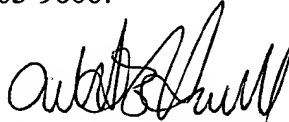
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EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell, can be reached on (703) 305-9703. The fax phone numbers for the Group are (703) 746-7238 for After-Final, (703) 746-7239 for Official Papers, and (703) 746-7240 for Non-Official and Draft papers.

14. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL  
PRIMARY EXAMINER  
GROUP 2142